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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,337	01/14/2000	Eric T. Kool	220.00040101	8254

7590 07/19/2002

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EXAMINER

CRANE, LAWRENCE E

ART UNIT	PAPER NUMBER
1623	12

DATE MAILED: 07/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/483,337</b>	Applicant(s) <b>E. T. Kool</b>
	Examiner <b>L. E. Crane</b>	Group Art Unit <b>1623</b>

**- THE MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **--3--** MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be filed after six months from the date of this communication.
- If the prior for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 USC §133).

## Status

Responsive to communication(s) filed on -08/20/01 (IDS#3), 12/26/01 (amdt B) & 01/17/02 (Seq. ID & ECRF).  
 This action is **FINAL**.  
 Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

Claims -44-48, 50-54 & 56-60- are pending in the application. Claim(s) - have been cancelled.  
 Of the above claims -1-43, 49, 55 & 60-63- are withdrawn from consideration.  
 Claim(s) - is/are allowed.  
 Claims -44-48, 50-54 & 56-60- are rejected.  
 Claim(s) - is/are objected to.  
 Claims - are subject to restriction or election requirement.

## Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on - is  approved  disapproved.
- The drawing(s) filed on - is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119(a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).  
 All  Some \*  None of the CERTIFIED copies of the priority documents have been received.  
 received in Application No. (Series Code/Serial Number) -.  
 received in the national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: -.

## Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). -08-  Interview Summary, PTO-413  
 Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  Other: -.

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No claims have been cancelled, no claims have been added, and claims **16-63** have been amended as per the amendment filed December 26, 2001. An Supplemental Information Disclosure Statement (IDS) filed August 20, 2001 has been received with all cited references and made of record. The Sequence ID and ECRF received January 17, 2002 has been received, reviewed and found acceptable for entry into the STIC database. Examiner also notes a copy of the Figures including hand-written notations in red has been received. Examiner presumes that this has been submitted as a working draft, and therefore has not submitted same to drafting for a second review.

Claims **1-63** remain in the case.

Claim **1-43, 49, 55 and 61-63** are withdrawn from further consideration by the examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper **10**.

Applicant's election with traverse of **Group X**, claims **44-48, 50-54 and 56-60** in Paper No. **10** is acknowledged. The traversal is on the grounds that "... the claims are so interrelated that a search of one group of claims will reveal art [directed] to the others." Additionally applicant alleges "... substantial duplication of work on the part of the [USPTO]." And lastly, applicant asserts that ten separate filing fees would be required if all of the separate groups were pursued by applicant. These arguments are not found persuasive because applicant's central argument is apparently that all of the claims must be examined together because one search of one invention will produce art covering all of the other inventions. Examiner has had a search conducted on the elected invention, and based on a careful review of

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that search respectfully disagrees. Examiner also notes that the various groupings of claims are each directed to substantially different subject matter and that each group would be separately patentable if found allowable following appropriate search and consideration of the relevant 5 prior art.

*JRC*  
7/18/02

The requirement is still deemed proper and is therefore made FINAL.

Claims 44-48, 50-54 and 56-60 remain under examination.

LECrane:lec  
07/18/02

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Johann Richter, Ph.D., Esq.  
Supervisory Patent Examiner  
Technology Center 1600

Claims 44-48, 50-54 and 56-60 are rejected under 35 U.S.C. 15 §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 44, 50 and 56 beginning at line 4, the terms "comprises" and "comprising" render the metes and bounds of the claim indefinite, 20 particularly when said terms are used in reference to chemically modified starting materials and products where the noted terms imply the absence of a complete description of the structural features of said chemically modified starting materials and products.

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In claim **44 and 56** at line 13 and claim **50** at line 14, the term "substantially" is per se indefinite. Deletion of said term is respectfully requested.

5 In claims **44, 50 and 56** at the last line, the term "detecting" renders each of the noted claims incomplete because the noted claims fail to provide for any substituents on the noted starting compounds or products which would permit detection or, no alternative method of detection is provided for within the step thereby rendering last process step in each of the noted claims incomplete.

10 Claims **45, 51 and 57** lack proper antecedent basis in an independent claim because there is no provision in any of claims **44, 50 and 56** for detectable substituents on any of the starting materials or products. Applicant may elect to address this problem by amending the term "comprises" in each of the initially noted claims to read -- further comprises --.

15 The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

20 "A person shall be entitled to a patent unless -  
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."  
25 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

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Claims 44-48, 50-54 and 56-60 are rejected under 35 U.S.C. §102(b) as being anticipated by Northwestern University '699 (PTO-1449 ref. AM).

5 Applicant is referred to the abstract at page 1, pages 13 and 17 and Figure 2 wherein the instant claimed invention has been anticipated.

Additionally applicant is respectfully requested to note that references AA, AB, AC, AF, AW, AU, AO, DV, DU and DT each include anticipatory subject matter and are therefore effective equivalents of the noted reference cited in the art rejection supra.

10 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 15 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(f) or (g) prior art under 35 U.S.C. §103(a).

20 Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are (703) 308-4556 and 703-305-3592.

25 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E.

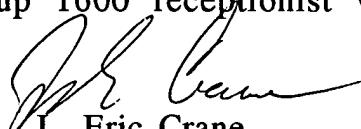
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Crane whose telephone number is **703-308-4639**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Johann Richter, can be reached at (703)-308-4532.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is **703-308-1235**.

10 LECrane:lec  
**07/18/02**

  
L. Eric Crane  
Patent Examiner  
Group 1600